

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: George Bradley Hobbs Examiner: Saeid Ebrahimi-Dehkordy
Serial No.: 09/734,295 Group Art Unit: 2623
Filed: December 11, 2000 Docket No.: 10003974-1
Title: PRINT PROCESSING SYSTEM AND METHOD WITH PRINT JOB
ADVERTISING

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DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Declaration is submitted to establish prior invention of the subject matter of the present patent application in the United States. The person making this Declaration is the inventor George Bradley Hobbs,

Accompanying this Declaration are Exhibits A through E to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994 coupled with due diligence from prior to the earliest effective date of the Kawai patent up to the filing date of the present patent application (i.e., constructive reduction to practice).

Declaration under 37 C.F.R. § 1.131

Serial No.: 09/794,295

Filed: December 11, 2000

Docket No.: 10003974-1

TITLE: PRINT PROCESSING SYSTEM AND METHOD WITH PRINT JOB ADVERTISING

Exhibit A (3 pages) includes a copy of HP Invention Disclosure No. 10003974 submitted by the inventor George Bradley Hobbs and received by the HP Legal Department prior to the earliest effective date of the Kawai et al. US Patent No. 6,404,994. This invention disclosure describes subject matter of the present patent application.

Exhibit B (1 page) includes a copy of a letter from HP Patent Attorney-Outsourcing Manager Steven R. Ormiston to patent attorney Steven E. Dicke of Dicke, Billig & Czaja dated June 7, 2000 (a date prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994), requesting a quote of the cost to prepare and file a U.S. patent application based on HP Invention Disclosure No. 10003974-1 (i.e., the present patent application).

Exhibit C (1 page) includes a Request for Quote and Engagement Letter Agreement for the preparation and filing of a US patent application based on HP Docket No. 10003974-1 (i.e., the present patent application). The agreement was signed by patent attorney Steven E. Dicke of Dicke, Billig & Czaja on June 13, 2000 and by HP Patent Attorney-Outsourcing Manager Steven R. Ormiston on June 19, 2000 (dates prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994).

Exhibit D (2 pages) includes a copy of an invoice dated November 1, 2000 from Dicke, Billig & Czaja to Hewlett-Packard Company for the preparation of the patent application based on HP Invention Disclosure No. 10003974-1 (i.e., the present patent application). From this invoice, it can be seen that acts in preparation of the patent application occurred between at least June 14, 2000 (a date prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994) and October 31, 2000.

HP Invention Disclosure No. 10003974-1 (i.e., the present patent application) was one of a group of related disclosures (10003974-1 and 10003973-1) for which related patent applications were prepared, as identified in the "Cross-Reference to Related Applications" of the present patent application. Those related applications were part of a docket of cases prepared by patent attorneys Steven E. Dicke and Scott A. Lund of Dicke, Billig, & Czaja between at least June 14, 2000 (a date prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994) and October 31, 2000. Work on these related applications contributed substantially to the ultimate preparation of the present patent application.

Declaration under 37 C.F.R. § 1.131

Serial No.: 09/734,295

Filed: December 11, 2000

Docket No.: 10003974-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH PRINT JOB ADVERTISING

Exhibit E (1 page) includes a copy of a letter from patent attorney Steven E. Dicke of Dicke, Billig & Czaja to HP Patent Attorney-Outsourcing Manager Steven R. Ormiston dated October 31, 2000. This Letter was accompanied by a draft of the patent application prepared for HP Invention Disclosure No. 10003974-1 (i.e., the present patent application) as reviewed and approved for filing by the inventor. The patent application was subsequently filed on December 11, 2000.

From these exhibits, it can be seen that the subject matter of the present patent application was conceived in the United States prior to the earliest effective date of June 26, 2000 of the Kawai et al. US Patent No. 6,404,994 coupled with due diligence from prior to the earliest effective date of the Kawai patent up to the filing date of the present patent application (i.e., constructive reduction to practice).

As a person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: George Bradley Hobbs Date: 1/08
George Bradley Hobbs

EXHIBIT A

INVENTION DISCLOSURE		PAGE ONE OF			
FDNO 10003974		DATE RCVD [REDACTED]			
ATTORNEY LRS					
Instructions: The information contained in this document is COMPANY CONFIDENTIAL and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.					
Descriptive Title of Invention: Advertising subsidized or profitably Printed Material					
Name of Project: DIW/Production Workflow analysis					
Product Name or Number:					
Was a description of the invention published, or are you planning to publish? If so, the date(s) and publication(s): <i>No</i>					
Was a product including the invention announced, offered for sale, sold, or is such activity proposed? If so, the date(s) and location(s): <i>No</i>					
Was the invention disclosed to anyone outside of HP, or will such disclosure occur? If so, the date(s) and name(s): <i>No</i>					
<small>Any of the above disclosures will occur within 3 months, call your IP attorney or the Legal Department now at 1-888-4319 or 970-587-4719.</small>					
Was the invention described in a lab book or other record? If so, please identify (lab book #, etc.) <i>No</i>					
Was the invention built or tested? If so, the date: <i>No</i>					
Was the invention made under a government contract? If so, the agency and contract number: <i>No</i>					
Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the Inventor(s) and witness(es).					
A. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.) B. Advantages of the invention over what has been done before. C. Problems solved by the invention. D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.)					
Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: [Signature] [Initials]					
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
<small>(If more than four inventors, include additional information on another copy of this form and attach to this document)</small>					

EXHIBIT A

INVENTION DISCLOSURE		COMPANY CONFIDENTIAL	PAGE	OF
Signature of Witness(es): (Please try to obtain the signature of the person(s) to whom invention was first disclosed.) The invention was first explained to, and understood by, me (us) on this date: [REDACTED] [REDACTED] Date/Signature Full Name [REDACTED] Signature [REDACTED] Full Name [REDACTED] Signature [REDACTED]				
Inventor & Home Address Information: (If more than four inventors, include add'l. information on a copy of this form & attach to this document)				
Inventor's Full Name Street [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Do you have a Residential P.O. Address? P.O. BOX [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Created as (nickname, middle name, etc.) [REDACTED] Citizenship [REDACTED]				
Inventor's Full Name Street [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Do you have a Residential P.O. Address? P.O. BOX [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Created as (nickname, middle name, etc.) [REDACTED] Citizenship [REDACTED]				
Inventor's Full Name Street [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Do you have a Residential P.O. Address? P.O. BOX [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Created as (nickname, middle name, etc.) [REDACTED] Citizenship [REDACTED]				
Inventor's Full Name Street [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Do you have a Residential P.O. Address? P.O. BOX [REDACTED] City [REDACTED] State [REDACTED] Zip [REDACTED] Created as (nickname, middle name, etc.) [REDACTED] Citizenship [REDACTED]				

EXHIBIT A

Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es).

A. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results etc.)

A system for allowing customers to allow other businesses to put advertising on a print job for pay or mutual benefit. For example, a Building contractor designs a brochure to explain his contracting service. The electronic job ticket for submitting the job identifies the construction and home 000

B. Advantages of the invention over what has been done before.
business along with customers who would get the printed material, # etc that describes the advertising target. Other related businesses could submit target fields & customers they would like to advertise too along with what they would pay. In this example, a building

C. Problems solved by the invention.
products company would potentially pay for the print job if they could put an ad on the back or a coupon for buying their product advantages.

Connecting advertisers with Print Job creati

D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).

automatically based on attributes of the print job type & distribution. Also, selling the space currently not used on paper for mutual benefit.

Hewlett-Packard Company
Legal Department
11311 Chinden Boulevard MS 314
Boise, Idaho 83714
Fax: 208/396-3958



June 7, 2000

EXHIBIT B

Steven R. Dicke
Dicke Billig & Czaja PA
Suite 1250 701 Building
710 Fourth Ave. South
Minneapolis, MN 55415

Re: Preparation and Filing of Patent Applications for the attached Invention Disclosures

~~DO NOT~~ File Directly To USPTO by: November 12, 2000

PDNO's: 10003974-1; 10003975-1; 10003979-1
10003981-1

Dear Steve:

We would like you to provide us with a quote of the cost for your firm to prepare and file (direct with the USPTO) a US patent application based on the HP invention disclosure identified above, a copy of which is enclosed. Your quote should be based on preparing and filing the application as specified on the attached green checklist.

You must use HP's USPTO forms and only reference HP's docket number on all filing documents and correspondence with the USPTO. All filing fees should be charged to HP's deposit account noted on the HP forms. Please do not prepare or file an assignment, HP will do that. Any questions regarding HP's forms and the JetForm software for use with HP's forms should be directed to Jennifer Torres at (650) 857-5796.

Your quote should be submitted on the enclosed Request for Quote And Engagement Letter Agreement. If your quote is accepted, we will return a fully executed copy of the Agreement to you for your records. The Agreement will not be binding on you or on HP until signed by HP's authorized representative.

If this Agreement is not signed and returned to HP, any bills submitted by you cannot be paid.

Sincerely yours,
Yvonne Bailey for Steven R. Ormiston
Steven R. Ormiston
Patent Attorney-Outsourcing Manager

SRO/yb
Enc: Invention Disclosure
Request for Quote/Agreement

JUN-19-2000 14:16

BOISE LEGAL

208 396 3958 P.11/17

Request for Quote and Engagement Letter Agreement

EXHIBIT C.

RE: Hewlett-Packard Docket No. 10003874-1

USSN:

- This is a request for a quote for the following services:
 This is a confirmation of your quote for the following services:

PREPARE

 Application File with USPTO Response Return to HP for filing Other _____**X YOUR FINISHED PRODUCT TO HP SHOULD INCLUDE ALL ITEMS ON THE ENCLOSED CHECKLIST.**

HP REQUIRED DATES:

Date for Receipt by HP

Nov. 12, 2000

Date to be Filed in PTO

HP Attorneys of Record: (to be included on the Declaration)

Customer Number **022879**

HP Primary Technical Contact: Brad Hobbs

Telephone No.: (208) 396-5971

FAX No.:

HP Entity: CPI.BOI

Address: 11307 Chinden Blvd.
Boise, ID 83714

ADDITIONAL TERMS OR INSTRUCTIONS:

On the DEC & FOA, please list LANE R. SIMMONS as designate person for the USPTO to contact regarding this application

TOTAL PRICE: [REDACTED]

(including Formal drawings)

I agree to the terms of this Agreement including the additional terms above, pursuant to the HP Procedures for Outside Counsel revised OCTOBER 18, 1999 a copy of which I have received and reviewed. This Agreement will not be binding on either party until signed by an authorized representative of HP.

Dicke Billig & Czaja PA

By: Steven E. Dicke
 Steven E. Dicke
 Dated: 6/13/00

HEWLETT-PACKARD COMPANY

By: Steven R. Ormiston
 Steven R. Ormiston

Dated: 6/10/00

DICKE, BILLIG & CZAJA, P.A.**Patent • Trademark • Copyright****ATTORNEYS**Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415
Telephone: (612) 573-2000 Facsimile: (612) 573-2005**RECEIVED**

NOV 04 2000

H. R. BOICE LEGAL

Page: 1

11/01/00

Account No: 302-128101M
Statement No: 6476

Hewlett-Packard Company
Financial Administrator
Legal Department, Finance Section
P.O. Box 10301
Palo Alto CA 94303-0890
U.S.A.

HP LEGAL FINANCE*LRS/SRQ*

Attn: Lane Simmons

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Stephen R. Ormiston, Esq.
HP Docket No.: 10003974-1**EXHIBIT D****Fees**

06/14/00 Analyze invention disclosure; Discussions with HP inventors RE:HP trip.

06/26/00 preparing for and in inventor conference

06/27/00 Discussion of invention disclosure with B. Hobbs and D. Palmer at HP - Boise.

09/26/00 preparing for and in inventor conference

10/11/00 drafting claims and preparing specification for patent application

10/12/00 drafting claims for patent application; preparing drawings and specification for patent application

10/13/00 preparing specification for patent application

10/18/00 preparing specification for patent application

10/19/00 preparing specification for patent application

10/20/00 preparing specification for patent application

10/27/00 Discussions with S. Lund; Review patent application.

10/31/00 preparing specification for patent application
Prepare/review application filing papers; filing of application with U.S. Patent Office.

For Current Services Rendered

~~Hewlett-Packard Company~~Page: 2
11/01/00Account No: 302-128101M
Statement No: 6476

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Stephen R. Ormiston, Esq.
HP Docket No.: 10003974-1**EXHIBIT D**Expensee

10/19/00 Patent Request
 10/19/00 Patent Request
 10/31/00 Long Distance Phone Charges
 10/31/00 Photocopy Charges
 10/31/00 Postage (First class mail, Express Mail, Federal Express, etc.)

Total Expenses

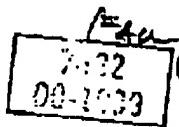
Advances

06/26/00 Travel Expenses - plane fare to Boise, ID

Total Advances

Total Current Work

Balance Due



Whitney Allister
 12/08/00

12/13/00

165940
19

**TERMS: NET 30 DAYS FROM DATE OF INVOICE
 Payments received after the first of the month will reflect
 on next month's statement. For questions regarding your
 account, please call Tammy at (612) 573-0079.

DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright
ATTORNEYS

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415
Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Steven E. Dicke
Direct Dial: (612) 573-2002

EXHIBIT E

October 31, 2000

Steven R. Orniston, Esq.
HEWLETT-PACKARD COMPANY
Legal Department
11307 Chinden Boulevard, M/S 314
Building #7
Boise, ID 83714

via Federal Express
B22473219820

RE: U.S. Patent Application
PRINT PROCESSING SYSTEM AND METHOD WITH
INTERFACE ADVERTISING
HP File No.: 10003973-1
DBC File No.: H302.125.101

U.S. Patent Application
PRINT PROCESSING SYSTEM AND METHOD WITH
PRINT JOB ADVERTISING
HP File No.: 10003974-1
DBC File No.: H302.128.101

Enclosed for your review are the above-identified patent applications. These applications have been approved by the inventors. After I hear from you, I will proceed with obtaining inventor signatures and filing these applications with the USPTO.

If you have any questions regarding this matter, please contact me at (612) 573-2002.

Regards,

DICKE, BILLIG & CZAJA, P.A.

Steven E. Dicke

SED:SAL:jac
Enclosures